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/Kathryn Marley/
Kathryn Marley

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of inventor(s): **Lukas van Ginneken et al.**	Group Art Unit: **2825** Examiner: **Vuthe Siek**
Application No. **10/828,547**	
Confirmation No. **3884**	**CUSTOMER NO. 36454**
Filing Date: **19 April 2004**	
Title: **Timing Closure Methodology**	

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the Office Action mailed 15 January 2009 (hereinafter "Office Action"), Applicants request a pre-appeal brief review. The period for reply to the Office Action expires on 15 April 2009.

In the present application, claims 2 and 4-15 are pending. The Examiner has rejected the claims for nonstatutory, obviousness-type double patenting, and for anticipation under 35 U.S.C. §102(b). Applicants have submitted Terminal Disclaimers to address the double patenting rejection in an accompanying paper. Applicants submit that the rejection under 35 U.S.C. §102(b) is based on clear error and should be reversed.

Rejection of Claims under 35 U.S.C. §102(b) is Based on Clear Error

The Examiner has rejected claims 2 and 4-15 under 35 U.S.C. §102(b) as being anticipated by Tsay *et al.* (US 5,461,576). Tsay *et al.* does not support a *prima facie* anticipation rejection. Therefore, the rejection is based on clear error.

Because the rejection is insufficient to establish a *prima facie* case on anticipation, Applicants do not present evidence concerning interpretation of the reference, but rather proceed on the basis of the "four corners" of the document.

As stated by the Federal Circuit in *Net Moneyin, Inc. v Verisign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008),

> Because the hallmark of anticipation is prior invention, the prior art reference--in order to anticipate under 35 U.S.C. § 102--must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements "arranged as in the claim."

Id. at 1369

Applicants demonstrate that the rejection is based on clear error for two reasons: (A) the reference does not disclose at least two steps in claim 2, and (B) the reference does not disclose the elements of the claim "arranged as in the claim."

The sole independent claim now pending reads as follows:

> 2. An automated method for designing an integrated circuit layout with a computer, comprising:
>
> (a) selecting a plurality of cells that are intended to be used in the integrated circuit layout;
>
> (b) determining initial delay values associated with the cells prior to determining an initial placement of the cells; and
>
> (c) performing an initial placement of the cells, including determining an initial size or area of the cells in response to the initial placement.

Tsay *et al.* describes a process in which cells are selected from a cell library, and used by a slack generator to produce delay information used for an initial placement. The process of Tsay *et al.* performs iterations on placement using the slack generator in order to provide a final placement. The basic structure of the Tsay *et al.* process is shown in its Fig. 3. The step of determining the initial size or area of the cells is not described in Tsay *et al.*

A. The Reference does Not Disclose at Least Two Steps in Claim 2

Tsay *et al.* does not describe at least two limitations in claim 2. First, Tsay *et al.* does not describe the last part of step (c) in the claim, reading "determining an initial size or area of the cells in response to the initial placement." Second, Tsay *et al.* does not describe step (b) in the

claim, reading "determining initial delay values associated with the cells prior to determining an initial placement."

Note that because of step (c) in the claim, the step (b) of "determining initial delay values ..." must also occur before determining the initial size or area of the cells. Tsay *et al.* does not disclose that relationship between determining initial delay values and determining initial size or area.

In Tsay *et. al.*, an initial placement is provided at block 124 in Fig. 3. See, column 7, lines 13-16. Although Tsay *et al.* does not mention initial sizing, according to the well known prior art as described in the background section on pages 1 and 2 of the present application, the initial size of the cell was at the time of this invention typically determined from the cell library in advance of initial placement.

Again, Tsay *et al.* does not explicitly discuss the determination of the initial size or area of cells at all. In the implementations described, information, presumably including size, about the cells subject of placement is retrieved from a standard cell library 12 and used by the slack generator before initial placement. (Tsay *et al.*, column 3, lines 38-56; and column 4, lines 6-31).

The Office Action relies upon the statement in Tsay *et al.* at column 2, lines 42-45, reading "Another advantage of the present invention is that an electronic design automation tool is provided in which the same concept can be applied to other applications for timing optimization, such as routing, sizing and logic synthesis." This passage in Tsay *et al.* is not relevant to the claim limitations concerning "determining initial size or area of the cells in response to initial placement". It does not mention initial sizing. It does not establish any relationship between initial sizing and initial placement as required by the claims. It does not establish any relationship between initial sizing and determining initial delay values as required by the claims.

A priori, there is no description in Tsay *et al.* of a process as required by claim 2, which includes determining initial size or area in response to initial placement, and determining initial delay values before determining initial size or area.

B. The Reference does Not Disclose the Elements of the Claim "Arranged as in the Claim

It is indisputable that the reference does not describe the elements of claim 2, "arranged as in the claim." For this second reason, the rejection is based on clear error, and should be reversed. See, *Ex parte* Magnus Nilsson, Appeal No. 2007-2376, (BPAI, Feb. 25, 2008).

The Examiner appears to argue, though not explicitly so, that Tsay *et al.* would be read by persons of skill as disclosing the claimed steps, including determining an initial size or area of the cells in response to initial placement. Applicants disagree as explained above. Applicants submit that it is insufficient for the Examiner to find that one of skill in the art would interpret the reference to teach initial sizing in some unstated form. Rather, there must be description in the reference that shows the claimed elements "arranged as in the claim." The Office Action does not address this requirement for a finding of anticipation. Furthermore, the reference does not support it.

C. Dependent Claims 4-15 are Not Anticipated

Claims 4-15 depend from claim 2, and are not anticipated by Tsay *et al.* for at least the same reasons. Reference is made to the RESPONSE/AMENDMENT filed on 03 November 2008 for further discussion of these claims.

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CONCLUSION

Accordingly, the rejection of claims 2 and 4-15 should be reversed, because Tsay *et al.* is insufficient to establish *prima facie* anticipation. Applicants respectfully submit that the pending claims are allowable.

Fee Authorization. The Commissioner is authorized to charge any fee determined to be due in connection with this communication, or credit any overpayment, to our Deposit Account No. 50-0869 (SYNP 1006-0).

Respectfully submitted,

Dated: 13 April 2009

/Mark A. Haynes/

Mark A. Haynes (Reg. No. 30846)

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
(650) 712-0340 phone
(650) 712-0263 fax